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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,043	10/03/2003	Gary A. Foos	14222/YOD ITWO:0070	1647

7590 02/05/2007
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EXAMINER

COCKS, JOSIAH C

ART UNIT	PAPER NUMBER
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3749

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/679,043

Applicant(s)

FOOS ET AL.

Examiner

Josiah Cocks

Art Unit

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 11/14/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-19, 31 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-19 and 31 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2006 has been entered.

Claim Objections

2. Claims 1-8 are objected to because of the following informalities: In line 2, "the flow of cutting oxygen" should read "a flow of cutting oxygen". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 8, 36, 39, and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,666,479 to Clinton ("Clinton").

Clinton discloses in the specification and Figs. 1-5 an invention in the same field of endeavor as applicant's invention and as described in applicant's claims 1-6, 8, 36, 39, and 41-

Art Unit: 3749

43. In particular, Clinton shows a torch (10) having a torch butt with an attached handle portion (17) (see Fig. 1), a valve assembly including valve block (22), valve member (23) and valve operating mechanism (including at least portions 35, 37, 38, and 42) operable to control a first flow of fluid through the torch butt (see Fig. 2 and col. 3, lines 25-36). The torch butt includes a dedicated passage (24 and 25) for the flow of cutting oxygen.

In regard to the recitation that the lever is “mutually exclusively” securable to pivot about a first portion of the torch butt or alternatively the second portion of the torch butt (e.g. at least claims 1 and 43), this structural relationship is considered to be present in Clinton. In Clinton, a lever (21) is selectively securable to pivot about first and second portions of the torch butt via pins (33 and 34). The openings (49 and 50) of the torch handle are arranged respectively in a first configuration in which one opening registers with the upper pin (34) and the other registers with the lower pin (33) and vice versa (see at least col. 4 line 46 through col. 5, line 5, see also Fig. 5). This arrangement is considered to meet the “mutually exclusive” recitation of applicant’s claims.

Further, lever (21) is clearly shown as being disposed “at least substantially” outside the torch butt in an accessible position (see at least Figs. 1 and 2).

The valve operating mechanism, including lever (21) is arranged in a first orientation relative to the torch butt and may be moved to a second portion that is inverted/reversed from the second position (see Fig. 1 and col. 4, line 46 through col. 5, line 15). Further, valve member (23) is shown as a separate portion from valve block (22) (note distinct hatching, Figs. 2-4). This valve member (23) slides within valve block/body (22) in order to open and close the valve (see col. 3, line 37 through col. 4, line 26). Though this valve member (23) is not required to be

Art Unit: 3749

removed to invert the orientation of the valve operating mechanism, this valve member (23) is capable of sliding movement within the central bore (24) of valve block (22) (see Figs. 2 and 3). When the lever (21) and arm (35) are removed to be reversed, the valve would be capable of being removed from the bore, and is therefore properly regarded as removable. Further, this valve member (23) is shown in Figs. 2-4 to be symmetrical, and thus when removed and reinserted in a second mutually opposed position would enable the torch to function as normal.

In regard to at least claims 41-43, as noted above the valve member (23) is symmetrical and capable of being removed and reinserted in a second mutually opposed position. This capability of being placed in a second mutually opposed position is considered to render the valve member “reversible” as claimed. Arm (35) is considered the reversible valve actuator claimed (see at least Figs. 3 and 4 and note reversal of this arm 35).

Clinton further discloses that the torch includes the necessary sealing and sealing means (see col. 3, lines 37-64), a second throttling valve assembly (16), and handle portion (17) has an upper radius and a lower radius that are uniform along the length of the handle (see Fig. 5).

5. Alternatively, claims 1-6, 8, and 36-40 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,709,446 to Miller (“Miller”).

In regard to the recitation in the preamble of a “torch,” a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claims does not depend on the preamble for completeness but, instead, the process steps of structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152,

Art Unit: 3749

88 USPQ 478, 481 (CCPA 1951). Further, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999); see also MPEP 2111.02. In this case, the body of the each of the claims do not rely on the preamble for completeness and state merely that the intended use of the invention. Accordingly, the recitation of "torch" is not considered a limitation in claim construction of these claims.

In regard to the recitation of "torch butt", this is regarded as simply of intended use of the butt. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Also, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114 (*citing In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)). Further, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claims.

Art Unit: 3749

See MPEP 2114 (*citing Ex parte Masham*, 2 USPQ2d 1647 (BD. Pat. App. & Int. 1987)). In this case, the tool butt formed by the valve housing (43) and channels (39) and (40) beneath handle (62) (see col. 3, lines 39-45) in Miller is considered structurally identical to the torch butt of applicant's invention and would be capable of functioning as the butt of a torch. Accordingly, applicant's claim limitation is considered to read on the toll butt (62) of Miller.

Miller discloses in the specification and Figs. 1-11 a portable tool and control valve as described in applicant's claims 1-6, 8, and 36-40. In particular, Miller shows a tool includes a handle (62) that covers a portion of the tool butt formed by valve housing (43) and channels (39) and (40) (see col. 3, lines 39-45), a valve body (11) including a valve assembly (see components within valve housing 43) with valve (see at least Fig. 2). The valve assembly is removable from and positionable in the tool butt in two mutually opposed positions (see at least Figs. 2 and 3 and col. 3, lines 54-70). Lever (64) is also inverted in the same manner as the valve assembly and selectively positioned between a first and second portion (see at least Figs. 2 and 3). The valve assembly includes a dedicated passageway (see bore 44) that receives a fluid flow when the valve assembly is the opposed positions.

In regard to the recitation that the lever is "mutually exclusively" securable to pivot about a first portion of the torch butt or alternatively the second portion of the torch butt, this structural relationship is considered to be present in Miller. As shown particularly in Figs. 2 and 3 of Miller, handle (64) is secured in a first orientation via pin (65) (Fig.2) and a second orientation via pin (65) that is inverted from the first orientation and considered mutually exclusively securable as recited in applicant's claims.

Further, lever (64) is clearly shown to be disposed "at least substantially" outside the

Art Unit: 3749

In regard to at least claim 36, Miller shows a first inlet that would be capable of receiving fuel (note inlet 36 and also the inlet for tube 77 in the embodiment of Figs. 6-11) and a second inlet (at least 58). Further the valve is clearly shown to be arranged crosswise relative to the longitudinal axis of the body (see at least Fig. 6).

In regard to at least claim 37, the valve is actuated in a direction askew to the longitudinal axis of the tool transitions.

In regard to at least claim 38, note the control of fluid through passageways (39 and 40).

In regard to at least claim 39, the inlet (at least 58) is configured to receive any pressurized gas (see col. 2, lines 6-9).

In regard to at least claim 40, note at least passageway (35).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 3749

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clinton as applied to claim 1 above in view of U.S. Patent No. 5,571,427 to Dimock et al. ("Dimock").

Clinton discloses all the limitations of claim 7 except that the handle has a skull-shaped cross section.

Dimock teaches a handle for a torch in the same field of endeavor as both applicant's invention and Clinton. In Dimock the torch includes a handle (16) that has a D/skull shaped cross section (see Fig. 6).

Therefore, in regard to claim 7, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the torch handle of Clinton to incorporate the D/skull shape of Dimock as this shape desirably provides a better ergonomic fit and better gripping surface for the hand of the operator and reduces the wasted space associated with rounded handles (see Dimock, col. 5, lines 11-15).

9. Alternatively, claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as applied to claim 1 above in view of U.S. Patent No. 5,571,427 to Dimock et al. ("Dimock").

Miller discloses all the limitations of claim 7 except that possibly that the handle has a skull-shaped cross section.

Dimock teaches a handle for a tool in the same field of endeavor as both applicant's invention and Miller. In Dimock the torch includes a handle (16) that has a D/skull shaped cross section (see Fig. 6).

Therefore, in regard to claim 7, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the torch handle of Miller to incorporate the D/skull shape of Dimock as this shape desirably provides a better ergonomic fit and better gripping surface for the hand of the operator and reduces the wasted space associated with rounded handles (see Dimock, col. 5, lines 11-15).

Allowable Subject Matter

10. As previously indicated, claims 14-19 and 31 are allowable over the prior art.

Response to Arguments

11. Applicant's arguments filed 11/14/2006 regarding claims 1-8 and 36-43 have been fully considered but they are not persuasive.

Regarding Clinton

Applicant argues that arm (35) in Clinton can not be considered applicant's recited lever. The examiner agrees, however, arm (35) is regarded as a portion of the valve assembly that is in turn connected and operated by lever (21).

Applicant also argues that lever (21) cannot be the recited lever. The examiner does not agree. Lever (21) is unambiguously shown as located "substantially" outside the torch butt of Clinton (see at least Figs. 1 and 2). Further, this lever is clearly shown as having multiple

Art Unit: 3749

orientations with relation to the torch butt (see Fig. 1). As noted above, these orientations are considered mutually exclusively securable as recited.

Applicant also argues that the valve bore (24) of Clinton does not extend crosswise through the valve body relative to the longitudinal axis of the valve body. The examiner does not agree. The valve bore (24) of Clinton is broadly considered to have portions of the passage that form the bore (24) that extend in both the lengthwise and crosswise directions of the torch (10) thereby meeting applicant's claim.

Applicant also argues that the valve member of Clinton is not reversible relative to opposite ends of the valve passage. The examiner does not agree. As was previously noted, and noted above, valve member (23) is capable of sliding movement within the central bore (24) of valve block (22) (see Figs. 2 and 3). When the lever (21) and arm (35) are removed to be reversed, the valve would be capable of being removed from the bore, and is therefore properly regarded as removable. Further, this valve member (23) is shown in Figs. 2-4 to be symmetrical, and thus when removed and reinserted in a second mutually opposed position would enable the torch to function as normal.

Regarding Miller

Applicant argues that the recitation of "torch butt" must be regarded to distinguish over the tool butt (62) of Miller. The examiner does not agree. As noted above the recitation of "torch butt" is considered simply a statement of intended use. Further, the tool of Miller and its butt (62) is structurally identical to the apparatus claimed by applicant. Applicant intends his device to function as a torch, however, the examiner notes that it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus

Art Unit: 3749

must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114 (*citing In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)). Further, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claims. See MPEP 2114 (*citing Ex parte Masham*, 2 USPQ2d 1647 (BD. Pat. App. & Int. 1987)). In this case, as the tool of Miller is structurally identical to the device claimed by applicant, that applicant intends his device to function as a torch does not distinguish from the prior art of Miller.

Applicant also argues that the recitation of a “a dedicated passage for the flow of cutting oxygen” is positive recitation of a flow of oxygen. The examiner does not agree. Applicant’s claims has been construed as claiming a passage that is intended to carry of flow of oxygen. As noted above, the intended use of apparatus does not serve to structurally distinguish over the prior art if the prior art would be capable of performing the function. The passage (44) of Miller would be capable of conveying a fluid such as cutting oxygen thereby meeting applicant’s limitation and claim.

Applicant also argues that Miller does not show a lever that is “mutually exclusively securable to pivot about a first portion of the torch butt or alternatively a second portion of the torch butt.” The examiner does not agree. As shown clearly in at least Figs. 2 and 3 of Miller, the handle (62), lever (64) and valve components within housing 43) are shown in two distinct orientations relative to the rest of the tool. These two distinct orientations of at least the lever are

Art Unit: 3749

considered to suggest the “lever that is mutually exclusively securable to pivot about a first portion of the torch butt or alternatively a second portion of the torch butt” as recited.

Applicant also argues that claims 36 is positively reciting a “fuel”. The examiner does not agree. Applicant’s claim has been construed as positively recited a first inlet that is intended to receive a fuel. Per the authority noted above, as Miller also shows a first inlet that would be capable of receiving any fluid, including a fuel, applicant’s claim does not structurally distinguish applicant’s invention over the prior art of Miller.

Applicant has also argued that Miller does not suggest a the lever that is “selectively securable to a first portion of the valve body or a second portion of the valve body opposite the first portion. In support of this argument, applicant asserts that because Miller teaches only one pin (65) and one corresponding hole, applicant’s claim is distinguished. The examiner does not agree. As previously noted, Miller clearly shows to separate and distinct orientations of lever (64) with respect to the main body portion of the tool (see at least Figs. 2 and 3). It appears that handle (62) despite having only one hole (65) is rotated along with lever (64) and changes orientation with respect to the valving components. The two distinct orientations shown in at least Figs. 2 and 3 have been regarded to meet applicant’s claim language.

Applicant also argues that claim 41 is distinct from Miller. The examiner agrees with applicant’s comments and notes that claim 41 has not been rejected over the Miller reference.

Applicant does not separately argue the teachings of Dimock. Accordingly, this reference is considered to properly show that for which it has been cited.

Therefore, applicant’s claims 1-8 and 36-43 are not considered to patentably distinguish applicant’s invention over the prior art of record.

Conclusion

12. This action is made non-final. A THREE (3) MONTH shortened statutory period for reply has been set. Extensions of time may be available under the provisions of 37 CFR

1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on M-F 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Rinehart can be reached on (571) 272-4881. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/679,043

Page 14

Art Unit: 3749

jcc

February 1, 2007

A handwritten signature in black ink, appearing to read 'J. Cocks', with a long horizontal flourish extending to the right.

JOSIAH COCKS
PRIMARY EXAMINER
ART UNIT 3749